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MS160277.1

REMARKS

Claims 1-35 are currently pending in the subject application and are presently under consideration. A listing of all claims is at pages 2-8. Claims 33-35 have been amended herein to further emphasize various aspects of the claimed invention. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 33 and 34 Under 35 U.S.C. §102(e)**

Claims 33 and 34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Smith, *et al.* (US 6,477,703). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Smith, *et al.* does not teach or suggest each and every element of the subject claims.

A single prior art reference anticipates a patent claim *only if* it expressly or inherently *describes each and every* limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). "A claim is anticipated *only if each and every* element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical* invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)

Independent claims 33 and 34 recite *a component for structuring and installing a service pack installable on the system*. Applicants' claimed invention pertains to a novel software application tool and software application system that facilitates selective upgrade of at least one application, based upon application specific criteria, *e.g.*, setup and dependency parameters. In particular, the application specific parameters dictate an appropriate service pack to be **installed** by the tool or system in order to selectively upgrade the application(s) identified. Such application specific parameters ensure that the upgrade of the application, through installation of the service pack, is compatible with other applications coexisting on a computer system, and further ensures that the computer system is left in an operable state subsequent to installation of the service pack. Smith *et al.* does not teach or suggest this facility as set forth in applicants' claimed invention.

09/726,000

MS160277.1

On the other hand, Smith *et al.* discloses a software patch selection tool - in particular, Smith *et al.* identifies software patches and generates a list of recommended patches that can be ordered by another tool, the Xpatch patch ordering tool. (See *e.g.*, Abstract). Thus, the patches that are identified by Smith *et al.*'s patch selection tool must first be ordered by the Xpatch tool and subsequently manually loaded on to the computer system without the aid of a tool. (See, Col. 5, line 28-29). It is readily apparent that Smith *et al.* does not teach or suggest **a component for structuring and installing a service pack based on desired setup and dependency information** as in the claimed invention. Rather, Smith *et al.* is confined to a tool to identify software patches for future manual installation on a computer system.

In view of the foregoing, it is clear that Smith *et al.* does not teach or suggest applicants' invention as recited in independent claims 33 and 34. This rejection should be withdrawn.

## **II. Rejection of Claims 1-14, 17-20, 22-24 and 27-32 Under 35 U.S.C. §103(a)**

Claims 1-14, 17-20, 22-24 and 27-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smith *et al.* (U.S. Patent Number 6,477, 703) in view of Beelitz *et al.* (U.S. Patent Number 6,182,275). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Smith *et al.* nor Beelitz *et al.*, alone or in combination, teach or suggest applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993).

09/726,000

MS160277.1

Independent claims 1, 9, 22, 27 and 30 (and the respective dependent claims) recite: *selectively installing service packs ...according to desired setup and dependency information...* . The claimed invention is directed towards a novel system, method and software tool to selectively install software packs onto a computer system.

As stated *supra*, Smith *et al.* does not teach or suggest a software tool, method or system for *selective installation* of service packs let alone based on *desired setup and dependency information*. Smith *et al.* is confined to a method to select software patches without a method to install the identified patches on the computer system. Once patches have been identified by the tool in Smith *et al.* and ordered from the vendor, Smith *et al.* relies upon the user to physically install the identified patches. It is apparent therefore that Smith *et al.* does not teach or suggest applicants' claimed invention, but rather provides a method for identification of software patches for future *manual* installation by a user.

Beelitz *et al.*, teaches a system for specifying, ordering, and building, a build-to-order computer system; and this reference does not make up for the aforementioned deficiencies of Smith *et al.* The system of Beelitz *et al.* is directed to aiding a purchaser or designer in the process of gathering information for initial configuration of the aforementioned build-to-order computer system. Beelitz *et al.* generates a list of user specified hardware and software that is sent to a manufacturing facility for *subsequent installation* at a manufacturing facility. Beelitz *et al.*, does not teach or suggest a system, method or software tool to selectively *install service packs* on computer systems *as a function of desired setup and dependency information* as in the claimed invention.

In view of at least the forgoing, it is respectfully submitted that neither Smith *et al.* nor Beelitz *et al.* alone or in combination teach or suggest applicants' invention as recited in independent claims 1, 9, 22, 27 and 30 (and the respective associated dependent claims). Accordingly, it is respectfully submitted that the subject invention is not obvious in light of either Smith *et al.* or Beelitz *et al.*, and thus it is requested that this rejection be withdrawn.

09/726,000

MS160277.1

**III. Rejection of Claims 15, 16, 20, 21, 25 and 26 Under 35 U.S.C. §103(a)**

Claims 15, 16, 20, 21, 25 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smith *et al.* (U.S. Patent Number 6,477,703) in view of Beelitz *et al.* (U.S. Patent Number 6,182,275) and further in view of Curtis (U.S. Patent Number 6,442,754). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 15, 16, 20, 21, 25 and 26 respectively depend from independent claims 9 and 22. As noted above, both Smith *et al.* and Beelitz *et al.* fail to teach or suggest a system, method or software tool to *selectively install service packs as a function of desired setup and dependency information*, and Curtis fails to make up for the aforementioned deficiencies of these references with respect to the noted independent claims. Accordingly, this rejection should be withdrawn

**IV. Rejection of Claim 35 Under 35 U.S.C. §103(a)**

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Smith *et al.* (U.S. Patent Number 6,477,703). It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Independent claim 35 has been amended herein to recite *a component for structuring and installing a service pack ... based on desired setup and dependency information*. As stated above, Smith *et al.* does not teach or suggest such features of applicants' claimed invention and this rejection should be withdrawn.

09/726,000

MS160277.1

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CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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